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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	79011373
Applicant	RIGHT-ON CO., LTD.
Applied for Mark	HONEYSUCKLE ROSE
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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re the Application of: Right-On Co., Ltd.	Trademark Attorney: Melissa Vallillo
Application No.: 79/011,373	Law Office: 113
Filed: April 21, 2005	Docket No.: 127939
Mark: HONEYSUCKLE ROSE	

Trademark Trial and Appeal Board
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

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EX PARTE APPEAL BRIEF

Applicant, Right-On Co., Ltd. (hereinafter "Right-On"), through its attorneys, hereby appeals to the Trademark Trial and Appeal Board the decision of the Examining Attorney refusing registration of the mark HONEYSUCKLE ROSE in connection with *"clothing, namely, jeans, t-shirts, polo shirts, sweat shirts, sweaters, gloves and socks; belts; footwear, namely, sports shoes, mountaineering boots and sandals; headgear for wear, namely, caps and hats,"* as identified in the above application.

Background

Applicant filed an application for International Registration of the subject mark claiming priority based on its home country application and designating the United States, under the

Madrid Protocol, as a country in which an extension of protection was desired. The Examining Attorney refused registration of the mark under Section 2(d) of the Trademark Act based on the following mark identified in U.S. Registration No. 2653702:

Applicant responded that there is no likelihood of confusion between its mark and the cited mark on the bases of the differences in appearance, sound and commercial impression of the marks. The Examining Attorney again refused registration, disregarding Applicant's argument relating to commercial impression. Applicant filed a Request for Reconsideration to the Examining Attorney on December 6, 2006, which was subsequently denied on December 29, 2006. Applicant's Appeal, which was filed on December 8, 2006 (and suspended pending the outcome of the Request for Reconsideration) was resumed on January 8, 2007.

Argument

When considering the similarity of the marks, "[a]ll relevant facts pertaining to the appearance and connotation must be considered." *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000). The mark HONEYSUCKLE ROSE is distinguishable in terms of appearance, sound and commercial impression from the cited mark.

With respect to appearance, Applicant's mark includes the term ROSE. Also, the cited mark depicts the word HONEYSUCKLE in its design element as the blooming flower of a honeysuckle plant. By contrast, Applicant's stylized mark is featured on two lines in a blocked

font without any other design elements. Thus the *appearance* of the two marks is entirely dissimilar.

With respect to sound, the marks are also distinguishable. In addition to the fact that Applicant's mark contains one additional word, the mark HONEYSUCKLE ROSE places greater emphasis on the term ROSE, with the term HONEYSUCKLE used as an adjective or descriptor. Thus Applicant's mark is a mellifluous combination of terms with the emphasis on the closing ROSE, as opposed simply to the stated name of a type of plant.

The Office Action acknowledges that the comparison of marks is only the first part of the analysis under *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). The proper analysis of whether there is a likelihood of confusion between the marks must include an analysis of the connotation and commercial impression of the competing marks. *Id.* Applicant's mark conveys a wholly different connotation and commercial impression.

The cited mark is the name of a plant, the flower of which is depicted in the design element of that mark. By contrast, Applicant's mark is not the name of a plant or flower -- there is no such flower or plant as a "honeysuckle rose." The definition, attached to Applicant's Request for Reconsideration, contains no reference to flowers, which clearly suggests that the mark is a unitary term with a completely separate meaning from the meanings of its component parts. Indeed, even the extensive documentation on honeysuckle and roses provided by the Examining Attorney in her denial of reconsideration fails to include any evidence of or reference to such a flower or plant.

Rather, Applicant's mark has an associated meaning that refers to a term of endearment. In Applicant's mark, ROSE is the name of a woman, whose sweetness is exemplified by the sweet nectar of the HONEYSUCKLE, thus HONEYSUCKLE ROSE. Lyrics of the 1928 song "Honeysuckle Rose" by Fats Waller and Andy Razaf, a jazz standard, are likely the source of this cultural meaning of the term HONEYSUCKLE ROSE as referring to a woman:

EVERY HONEY BEE FILLS WITH JEALOUSY,
WHEN THEY SEE YOU OUT WITH ME.
GOODNESS KNOWS
YOU'RE MY HONEYSUCKLE ROSE

WHEN YOU'RE PASSIN' BY FLOWERS DROOP AND SIGH,
AND I KNOW THE REASON WHY.
GOODNESS KNOWS
YOU'RE MY HONEYSUCKLE ROSE

DON'T BUY SUGAR,
YOU JUST HAVE TO TOUCH MY CUP.
YOU'RE MY SUGAR.
IT'S SWEETER WHEN YOU STIR IT UP.

WHEN I'M TAKING SIPS FROM YOUR TASTY LIPS
SEEMS THE HONEY FAIRLY DRIPS.
GOODNESS KNOWS
YOU'RE MY HONEYSUCKLE ROSE

GOODNESS KNOWS
YOU'RE MY HONEYSUCKLE ROSE

DON'T BUY SUGAR,
YOU JUST HAVE TO TOUCH MY CUP.
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IT'S SWEETER WHEN YOU STIR IT UP.

WHEN I'M TAKING SIPS FROM YOUR TASTY LIPS
SEEMS THE HONEY FAIRLY DRIPS.
GOODNESS KNOWS
YOU'RE MY HONEYSUCKLE ROSE

Due to its popularity, the song was later covered by jazz superstar Louis Armstrong in 1938 (with Fats Waller) and 1955. The term HONEYSUCKLE ROSE gained further cultural importance in 1980 with the release of the film and accompanying soundtrack entitled HONEYSUCKLE ROSE, starring Willie Nelson and Amy Irving. This movie continues to have a strong following, especially among Willie Nelson's fan base. In fact, Willie Nelson continues to use the term HONEYSUCKLE ROSE as the name of his famous touring bus. See the Wikipedia reference of record.

Used in music and film, the term HONEYSUCKLE ROSE has taken on this cultural significance as evidenced by the numerous businesses that have appropriated this mark in their business names. Applicant is employing this cultural meaning in its use of the mark HONEYSUCKLE ROSE. As such, when consumers encounter Applicant's mark, completely different mental imagery is evoked than if the same consumers encountered the cited mark.

The Examining Attorney based her denial of reconsideration on the similarities of the word portions of the marks, stating, "The addition of the wording ROSE to the applicant's mark does not obviate the similarity between the marks because the applicant's mark incorporates the literal element of the registrant's mark entirely." In response, Applicant noted that it is well settled that a mark may entirely contain another mark without a finding of likelihood of confusion. *See In re Ferrero,* 479 F.2d 1395 (C.C.P.A. 1973), overturning rejection of registration for the mark TIC TAC for "candy" on the basis that it would be confused with the prior registered mark TIC TAC TOE for ice cream and sherbet); *The Conde Nast Pub, Inc v. Miss Quality, Inc.,* 507 F.2d 1404 (C.C.P.A. 1975) (no likelihood of confusion found between

COUNTRY VOGUE for women's dresses and VOGUE for a women's fashion magazine.)

In addition, overlap of wording between marks does not lead to a likelihood of confusion if the marks in their entireties convey significantly different commercial impressions. *See, e.g., Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004); *In re Farm Fresh Catfish Co.* , 231 USPQ 495 (TTAB 1986); *In re Shawnee Milling Co.* , 225 USPQ 747 (TTAB 1985); *In re S.D. Fabrics, Inc.* , 223 USPQ 54 (TTAB 1984).

Applicant further notes that the co-existence of these two marks on the U.S. Trademark Register for related or identical goods is not without precedent. U.S. Registration No. 2,968,888 for the mark HONEYSUCKLE for *"fragrance for personal use, room fragrance, cologne, bath oil, bath gel, body lotion, body cream,* in Class 3," and U.S. Registration No. 1,753,545 for the mark HONEYSUCKLE ROSE for *"complexion and body moisturizers; hair and scalp conditioners; and hair shampoo,"* also in Class 3, have co-existed on the Register since April 20, 2005, and have co-existed in commerce since 1999, based on the information in the registrations. As both of these marks are standard character marks, it could be argued that the marks are more similar than in the present case. Nonetheless, these marks have co-existed, presumably without incident either on the Trademark Register or in U.S. commerce.

In evaluating the similarities between marks, the emphasis must be on the recollection of the average purchaser who normally retains a general, rather than specific, impression of trademarks. *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). The cited mark is the name of a plant, and a flower of that plant is depicted in the design element of that mark. Accordingly, the average purchaser is likely to retain the image of the honeysuckle plant.

By contrast, Applicant's mark evinces the unrelated imagery of a woman associated with the term HONEYSUCKLE ROSE. This imagery includes romantic notions of feminine "sweetness." Because of this cultural significance, consumers are likely to perceive and retain a completely different impression than they would when encountering the term "honeysuckle" alone.

The Examining Attorney also asserts in her denial of reconsideration that the marks have a common meaning, namely, that the cited mark is the name of a flower and that Applicant's mark is comprised of two separate and distinct terms, each of which identifies a type of flower. The basic principle in determining confusion between marks is that marks must be compared *in their entireties*. It follows from that principle that likelihood of confusion cannot be predicated on dissection of a mark. *In re National Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 750-51 (Fed. Cir. 1985).

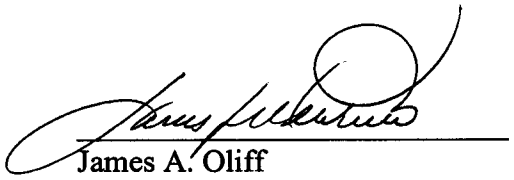
Although the individual literal elements of Applicant's mark are sometimes names of plants, these elements, when joined together, form the unitary mark HONEYSUCKLE ROSE, which is not the name of a plant. As such, the meanings of the two literal elements are subsumed into a new unitary term with suggestive connotations that play off of the characteristics of plants or flowers, e.g., sweetness and beauty, but that do not identify plants or flowers themselves. Such is the case with many compound terms in the English language, especially with respect to culturally significant terms, e.g., "rolling stone" as meaning an individual incapable of staying in one place for long; "black sheep" as meaning an outcast; etc. Just as these terms have meanings separate from their component parts, so too does Applicant's mark have a meaning separate from its parts.

Conclusion

Based on the preceding arguments, in concert with the documents and materials previously entered into the record, Applicant has provided clear evidence that there is no likelihood of confusion between its mark and the cited mark. Accordingly, Applicant respectfully requests that the refusal to register Applicant's mark by the Examining Attorney be reversed.

No fee is believed to be due in connection with the filing of this Appeal Brief. However, any fee deemed payable is authorized to be charged to Deposit Account No. 15-0461.

Respectfully submitted,



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